

Appl. No. 10/760,343
Amendment dated: March 8, 2005
Reply to OA of: December 8, 2004

REMARKS

Applicant acknowledges with appreciation the indication that claims 6 and 9 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has amended the claims to introduce new claim 15, which incorporates the limitations of claim 6 into the language of claim 1. Claim 15 is in condition for allowance. Claim 6 has been cancelled accordingly and claim 9 has been amended to depend from new claim 15. Claim 9 is in condition for allowance. Applicant has chosen not to amend the remaining claims, as it is believed that they are allowable as currently presented.

Applicant has submitted herewith a proposed drawing change to Figure 3. The change replaces reference numerals 32 and 34 on Figure 3 with reference numerals 44 and 46, respectively. This change is fully supported by the specification. The reason for the change is to help clarify what is meant by retainer as it used in the specification and the claims.

Claims 4, 5, 7 and 11-14 have been rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. The Office Action urges that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or which it is most nearly connected, to make and/or use the invention. The rejection has been carefully considered but is most respectfully traversed.

With respect to Claims 4, 5, 7, 11 and 14, the Office Action states that the claims set forth the shock-absorbing member as including thermoplastic urethane. This , according to the Office Action, seemingly contradicts the independent claims from which they depend because the independent claims recite that the shock-absorbing member is non-plastic. However, Applicant notes that the independent claims require that the shock-absorbing member be a "non-plastic composite material," not a "non-plastic"

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composite material. In other words, the claims require that the shock-absorbing member be a material other than a plastic composite material (PCM). The shock-absorbing member may be plastic, but not a plastic composite, as would be appreciated by one of ordinary skill in the art. Thus the inclusion of a thermoplastic urethane in a dependent claim is entirely consistent since it is not a composite.

With respect to independent Claim 12, the Office Action states that it cannot be ascertained from the written description what is represented by the "retainer." Applicant has amended Figure 3 so as to clarify this issue. The retainer referred to in Claim 12 corresponds to reference numerals 42, 44 and 46 in Figure 2 and reference numerals 44 and 46 in corrected Figure 3. As described in the specification, the retainers are fitted to respectively fill up the corresponding openings 24, 26 and 28 of the body 20. This can be more clearly seen now by considering Figure 2 in conjunction with corrected Figure 3. Reference numerals 42, 44 and 46 are not openings, but rather they are depressions in the shock-absorbing members that fit into and fill the openings 24, 26 and 28 of body 20, thus retaining the member 40 in position over body 20. Accordingly, Applicant believes that, when considered in light of the proposed drawing change and the specification, it is now clear what is meant by retainer in Claim 12.

In light of the above remarks and the proposed drawing change, Applicant respectfully asserts that the rejections under 35 U.S.C. §112, first paragraph, have been obviated and should be withdrawn.

The Office Action further rejects Claims 1-3, 8 and 10 under 35 U.S.C. §103(a) as being unpatentable over Bigolin (2003/0164629) in view of Pareux (FR 2626756). This rejection has been carefully considered but is most respectfully traversed.

Applicant is well acquainted with the Bigolin application (US 2003/0164629 A1), as it was cited by Applicant in the specification of the present invention. Bigolin discloses a bicycle saddle wherein the shell is formed of fiber-reinforced plastic and wherein holes in the shell are filled with a fiber-reinforced plastic having a hardness

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lower than that of the body. However, because the fiber-reinforced plastic generally uses a thermosetting resin as the matrix, the expected shock absorbing function is lost when solidified in the molding process.

The present invention is an improvement over the Bigolin bicycle saddle because it uses a non-plastic composite material (non-PCM) for the shock-absorbing member, which does not lose its shock-absorbing function upon undergoing the molding process. Because the member is resin-free, it is not solidified in the molding step and therefore retains the shock absorbing function. The elastic property of the non-PCM member is preserved to form a shock absorbing member.

The Office Action urges that Bigolin shows all claimed features of the instant invention with the exception of the shock absorbing member being made of non plastic composite material having a hardness lower than that of the body. In order to overcome this deficiency, the Office Action states that Bigolin may be combined with Pareux (FR 2 626 756), which discloses the concept of configuring a shock absorbing member as made of non plastic composite material, specifically from plastic foam or another flexible composite material. Applicant specifically traverses this rejection.

As mentioned above, the present invention contemplates that the shock-absorbing member must be non-plastic composite material (non-PCM). This may include using resin-free carbon-fiber fabric sheet and thermoplastic urethane, both of which are non-PCM's. To the contrary, the Pareux reference discloses plastic foam or another flexible composite material. Therefore, Pareux clearly fails to teach the use of a non-plastic composite material, and in fact, teaches away from using such a material by explicitly reciting the use of a composite material to achieve an advantageous result. Because the combination §103(a) rejection fails to recite each and every limitation of the claimed invention, the Applicant respectfully requests that the rejection be withdrawn.

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Further, the examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

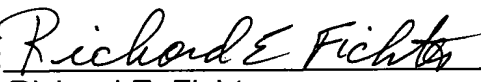
The Pareux reference is directed to a mattress or cushion that delays compaction, improves the appearance of the mattress or cushion and ensures the stability of the persons at rest. The present invention, to the contrary, is directed to a lightweight shell for a bicycle saddle containing an improved shock absorbing area. Applicant urges that the Pareux reference and the present invention are in non-analogous arts and do not aim to solve the same problem. Therefore, the Pareux reference cannot be properly used to support a §103(a) rejection and does not provide the necessary motivation for combining the references.

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In view of the above comments and further amendments to the claims and drawings, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

BACON & THOMAS, PLLC

By: 
Richard E. Fichter
Registration No. 26,382

625 Slaters Lane, 4th Fl.
Alexandria, Virginia 22314
Phone: (703) 683-0500
Facsimile: (703) 683-1080

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Amendments to the Drawings:

Changes to the drawings have been made in compliance with 37 C.F.R. 1.84. Amended figures which incorporate the desired changes can be found on an annotated drawing sheet presented at the end of this Amendment. An explanation of the changes made is presented in the Remarks section of this Amendment.